



APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/923,922	09/05/97	KUTSCHER	A 024444-413

EXAMINER
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IM71/0722

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ART UNIT	PAPER NUMBER
1774	5

DATE MAILED 07/22/98

07/22/98

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on 9/5/97
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-7 is/are pending in the application.  
Of the above, claim(s) 7 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-6 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to a tool, classified in class 428, subclass 472.
- II. Claim 7, drawn to a method, classified in class 427, subclass 255+.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as sputtering.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, different search and classification, a restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Grudziecki on 6-16-1998 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6.

Affirmation of this election must be made by applicant in replying to this Office action. Claim

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7 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The value of  $z$  in claim 3 is contradictory to the limitation in claim 1.

7. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the value of  $x$  in the layers where  $y > x$  have not been defined rendering the claims indefinite.

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>©</sup> of this title before the invention thereof by the applicant for patent.

9. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandvik (EP 0 693 574) or Ljungberg et al (5,487,625).

Sandvik or Ljungberg et al disclose the claimed titanium oxycarbonitride and alumina coating.

10. Claims 1, 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Ljungberg et al (5,766,782 or 5,674,564) or Nakamura et al (5,652,045).

Ljungberg et al or Nakamura et al disclose the claimed titanium oxycarbonitride and alumina coating.

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11. Claims 1, 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nystrom et al (5,135,801) or Mitsubishi Materials Corp (EP 0 709 484 or EP 0 685 572 or EP 0 594 875 or English translation of JP 25282-1978 or JP 6-10825) or Sumitomo Electric Ind. Ltd (EP 0 653 499).

The above references disclose the claimed titanium oxycarbonitride and alumina coating.

12. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Archene Turner, whose telephone number is (703) 308-4344. The Examiner can normally be reached Monday to Thursday from 8:30 AM to 6:00 PM.

A facsimile center has been established in Group 1700, Crystal Plaza 2, 8th floor, reception area. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-3599 (for official after final faxes) or (703) 305-5408 (for all other official faxes). This location should be used in all instances when faxing any correspondence to Art Unit 1774. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1774.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-235-0661.

*A. Turner*  
ARCHENE TURNER  
PRIMARY EXAMINER  
GROUP 1700